

REMARKS/ARGUMENTS

Claims 1-19 were pending at the time of the mailing of the outstanding Office Action. By this response, claims 1 and 19 are amended. No new claims have been added and no claims have been cancelled.

In the Office Action of 9 February 2004, the Examiner rejected claims 1-19 under 35 U.S.C. § 112, first paragraph, as being based on a disclosure which is nonenabling and as failing to comply with the written description requirement. Under 35 U.S.C. § 102(b), the Examiner rejected claims 1, 2, 5 and 19 as anticipated by Mehra et al. (US Pat. 5,170,802) ("Mehra '802") and claims 1, 3, 8, 9, and 13 as anticipated by Dahl et al. (US Pat. 5,531,779) ("Dahl '779"). Under 35 U.S.C. § 103(a), the Examiner rejected claims 7, 11, and 16 as being unpatentable over Mehra '802 in view of Laufer et al. (US Pat. 6,283,989) ("Laufer '989"), claims 10 and 17 as being unpatentable over Mehra '802 or Dahl '779, claims 14 and 15 as being unpatentable over Mehra '802, and claim 19 as being unpatentable over Mehra '802 or Dahl '779. The Examiner's rejections are traversed as follows.

The Examiner alleges that claims 1-19 are based on a disclosure which is nonenabling. Specifically, the Examiner indicates that there is no support in the specification for the limitation of the blood vessel into which the present invention is implanted "having a cross-sectional area along an entire length of the wire unit." However, one of ordinary skill in the art would recognize that a blood vessel would necessarily possess a cross-sectional area of some dimension in any given length of the blood vessel. Additionally, support for this limitation may be found throughout the specification, and particularly in the Figures. Figures 6-9 show various embodiments of the present invention with differing lengths, diameters and shapes. Further, paragraph 0008 indicates that the present invention "is deployed in the corresponding vessel and bears from the interior against the vessel wall." Therefore, one of ordinary skill in the art would recognize that the probe of the present invention would be adapted to be deployed

and subsequently expanded in a blood vessel having a cross sectional area along the length of the probe, as recited in claim 1.

The Examiner also alleges that claims 1-19 fail to comply with the written description requirement "because the original specification does not disclose 'wherein, in the second state, the probe does not project radially into the lumen along the length of the wire unit in a manner that reduces the cross sectional area of the blood (vessel).'" However, support for this limitation may be found in paragraph 0008, as mentioned above, which indicates that the present invention "is deployed in the corresponding vessel and bears from the interior against the vessel wall," and in paragraph 0049, which states, "The interior of the cylindrical wire unit is completely free so that flow of blood in the vessel is not impeded." Further support may be found in the Figures, which show that the probe does not project radially into the lumen along the length of the wire unit in a manner that reduces the cross sectional area of the blood vessel. Therefore, the Applicant maintains that claims 1-19 satisfy the provisions of 35 U.S.C. § 112, first paragraph.

Claims 1-3, 5, 8, 9, 13 and stand rejected under 35 U.S.C. § 102(b) and claims 7, 10, 11, 14-17 and 19 stand rejected under 35 U.S.C. § 103(a). By this amendment, claim 1 has been amended to recite that the wire unit comprises a plurality of portions, the portions being insulated from each other. Support for this amendment may be found in the specification in paragraph 52, in Figures 4 and 5 and in claim 6. Applicant asserts that claim 1 patentably distinguishes over the individual and combined teachings of the cited prior art. Likewise, claims 2-18, which depend from claim 1, either directly or indirectly, and contain all the limitations of claim 1, also patentably distinguish over the cited prior art.

The Examiner rejected claim 19 as unpatentable under 35 U.S.C. § 103(a). Claim 19 has been amended to independent form. The Examiner alleges that it would have been obvious to one of ordinary skill in the art to modify the feed line of Mehra '802 or Dahl '779 with a ring to form a bipolar electrode because bipolar electrodes are well known in

the art as a more efficient way of sensing and stimulating the heart. To establish a *prima facie* case of obviousness of an invention under 35 U.S.C. § 103(a), the Examiner must establish that there is some suggestion or motivation to modify the reference, that there is a reasonable expectation of success in making the modification, and that the reference teaches or suggests all of the claim limitations. (MPEP § 2143.) Even assuming, *arguendo*, that the use of a bipolar electrode is known in the art, the Examiner has not established that terminating the feed line with a ring (to form the bipolar electrode) is taught or suggested by Mehra '802 or Dahl '779. Therefore, the Applicant maintains that the Examiner has not established a *prima facie* case of obviousness of claim 19. Reconsideration of this rejection is respectfully requested.

In light of the amendments and arguments presented herein, reconsideration of claims 1-19 and the issuance of a Notice of Allowance is solicited.

The outstanding Office action was mailed on 9 February 2004. The Examiner set a shortened statutory period for reply of 3 months from the mailing date. Therefore, a response is due 9 May 2004. Because this date falls on a Sunday, this response is timely if filed on or before 10 May 2004. No fees are believed to be due with this response. However, in the event that a fee for the filing of his response is insufficient, the Commissioner is authorized to charge any fee deficiency or to credit any overpayment to Deposit Account 15-0450.

Respectfully submitted,



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